

**REMARKS**

Claims 1 through 34 are pending in this Application. Applicants acknowledge, with appreciation, the Examiner's indication that claim 15 contains allowable subject matter.

Claims 1, 16, 33 and 34 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment is apparent throughout the originally filed disclosure, noting that the amendments to claims 1 and 16 address perceived formalities. Applicants submit that the present Amendment does not generate any new matter issue.

**Claims 33 and 34 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.**

This rejection is traversed.

Specifically, claims 33 and 34 have been clarified by reciting "A computer-readable storage medium", subject matter clearly within 35 U.S.C. §101. Accordingly, withdrawal of the rejection of claims 33 and 34 under 35 U.S.C. §101 is solicited.

**Claims 1, 10 through 13, 16, 17, 26 through 28, and 30 through 34 are rejected under 35 U.S.C. §102(b) as anticipated by Thro et al. ("Thro").**

In the statement of the rejection, the Examiner asserted that Thro discloses a method and computer program code for obtaining an electronic mail service to a mobile station, the method comprising receiving an electronic mail message at the mobile station. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102(b) requires the identical disclosure in a single reference of each element of a claimed invention, as those

elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1308, (Fed. Cir. 2008); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002); *Candt Tech Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344 (Fed. Cir. 2001). There are fundamental differences between the claimed inventions and Thro that scotch the factual determination that Thro discloses, or even remotely suggests, the identically claimed inventions.

Specifically, in accordance with the claimed inventions, the user interface (mobile station) indicates, after reading each message, whether or not the message is divergent from the normal/general level as to the importance of the message [0046], wherein the importance of the message is determined based upon user preference [0047]. Clearly, and as one having ordinary skill in the art would have recognized: (a) the importance level of a message is determined at the mobile station; and (b) the basis for determination is user preference.

In contradistinction to the claimed inventions, Thro discloses that the determination of the message priority is determined **at the server** (Abstract, col. 3, lines 51-52), not at the mobile station as in the claimed inventions. In further contradistinction to the claimed inventions, Thro generates a priority matrix based on a combination of **message originator priority** and message recipient priority (Abstract, col. 4, lines 1-4).

The above differences between the claimed inventions are manifestly functionally significant. Indeed, Thro's system would deny the recipient the ability to filter out or delay messages according to the recipient's presences. For example, a message M may have the lowest level of priority for the recipient (the recipient is not willing to receive message M until all the other messages with higher levels of importance have been received). Based on the claimed invention, the recipient's wish is implemented by applying the recipient's priorities. On the

other hand, the same message M may have the highest level of priority for the originator, which will not affect the message presentation in the claimed invention. However, the combination of recipient priorities and originator priorities in the priority matrix disclosed by Thro may result in the message M being presented to the recipient before the messages to which the recipient has assigned a higher priority or higher level of importance.

The above argued functionally significant differences between the claimed inventions and Thro undermine the factual determination that Thro discloses the identically claimed inventions. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1, 10 through 13, 16, 17, 26 through 28, and 30 through 34 under 35 U.S.C. §102(b) for lack of novelty as evidenced by Thro is not factually viable and, hence, solicit withdrawal thereof.

**Claims 2 through 9 and 18 through 25 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon Thro in view of Horvitz.**

In the statement of the rejection, the Examiner asserted that one having ordinary skill in the art would have been led to modify Thro by applying at least one algorithm, in view of Horvitz. This rejection is traversed.

Specifically, claims 2 through 9 depend from independent claim 1, and claims 18 through 25 depend from independent claim 17. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of independent claims 1 and 17 under 35 U.S.C. §102(b) for lack of novelty as evidenced by Thro. The secondary reference to Horvitz does not cure the previously argued deficiencies of Thro. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants certainly do not agree that the requisite

basis to support the asserted motivation has been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988).

Further, Applicants separately argue the patentability of claim 2, which requires the application of at least one algorithm based on a statistical analysis of linguistic contents of the electronic mail message. Horvitz discloses portions of its descriptions in terms of algorithms and presents a standard definition for an algorithm [0025]. However, Horvitz has no reference to any algorithm for any kind of statistical analysis and not of linguistic contents. A step in the obviousness analysis is to “determine whether there was an apparent reason to combine the known elements in the fashion claimed.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). A rejection for obviousness must include “articulated reasoning with some rational underpinning to support the legal conclusion.” *Id.*, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). No such articulated reasoning has been presented on this record. Certainly, the general disclosure of Horvitz cannot be a sufficient basis upon which to predicate the conclusion that one having ordinary skill in the art would have realistically been led to zero in on Thro and modify the disclosed method in some unidentified manner to arrive at the claimed invention. Moreover, as previously discussed, even the proposed combination would not result in the claimed invention.

Applicants, therefore, submit that the imposed rejection of claims 2 through 9 and 18 through 25 under 35 U.S.C. §103(a) for obviousness predicated upon Thro in view of Horvitz is not factually or legally viable and, hence, solicit withdrawal thereof.

**Claims 14 and 29 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon Thro in view of Tarnanen et al. (“Tarnanen”).**

This rejection is traversed.

Specifically, claim 14 depends from independent claim 1, and claim 29 depends from independent claim 17. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of independent claims 1 and 17 under 35 U.S.C. §102(b) for lack of novelty as evidenced by Thro. The secondary reference to Tarnanen does not cure the previously argued deficiencies of Thro. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants certainly do not agree that the requisite basis to support the asserted motivation has been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*.

Applicants, therefore, submit that the imposed rejection of claims 14 and 29 under 35 U.S.C. §103(a) for obviousness predicated upon Thro in view of Tarnanen is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing, it is apparent that the imposed rejections have been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-519-9954 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

March 11, 2010

Date

/Arthur J. Steiner/

Arthur J. Steiner

Attorney/Agent for Applicant(s)

Reg. No. 26106

918 Prince Street  
Alexandria, VA 22314  
Tel. (703) 519-9951  
Fax (703) 519-9958